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In re Application of ARIMA et al. :
Application No.: 09/403,603 :
PCT No.: PCT/JP98/01844 :
Int. Filing Date: 22 April 1998 : DECISION
Priority Date: 23 April 1997 :
Attorney Docket No.: P64708US0 :
For: ELECTRODE AND BATTERY :

This is a decision on applicants' "Response to Notification of a Defective Response and Response to Notification of a Defective Oath or Declaration under 35 U.S.C. 371(c)(4)", considered as a petition under 37 CFR 1.182 and filed in the United States Patent and Trademark Office (USPTO) on 18 September 1999.

BACKGROUND

On 22 April 1998, applicants filed the above-captioned international application, which claimed a priority date of 23 April 1997, and which designated the United States.

On 24 November 1998, a Demand was filed electing the United States. Accordingly, the deadline for entry into the national stage was extended to thirty months or 23 October 1999.

On 22 October 1999, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee.

On 03 December 1999, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration must be filed in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for filing the declaration after the thirty month period.

On 31 May 2000, applicants submitted a declaration executing PCT/JP98/01844 with a petition for extension of time for a five month period. A copy of the declaration was again submitted by facsimile on 15 June 2000.

On 29 June 2000, Notification of Defective Response (Form PCT/DO/EO/916) and Notification of Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicants indicating that the declaration submitted was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68 and did not identify the inventors. Specifically, Form PCT/DO/EO/916 indicated that "the declaration has two sole or first inventors, Yoichiro Arima and Hisashi Tsukamoto. The names of the fifth and seventh inventors on the declaration does not correspond with the published IA [international application]".

On 18 September 2000, applicants refiled the originally filed declaration, with handwritten revisions to the inventor order and changes in two inventors' last names in ink and highlighted. A change of address was also filed.

DISCUSSION

The publication of the above referenced international application lists nine inventors in the following order: Yoichiro ARIMA, Hisashi TSUKAMOTO, Shigeru AIHARA, Daigo TAKEMURA, Hisashi SHIODA, Hiroaki URUSHIHATA, Juri ARAKANE, Shyoji YOSHIOKA, and Makiko KISE.

A review of the application file reveals that on 31 May 2000 applicants filed a five page declaration consisting of three unnumbered pages and numbered pages Two and Three. One of the unnumbered pages indicated "sole or first inventor" and was executed by Yoichiro ARIMA. A second unnumbered page of the executed declaration indicated "sole or first inventor" and was executed by Hisashi TSUKAMOTO. The page numbered "two" of the declaration indicated "second inventor" Hisashi TSUKAMOTO and "third inventor" Shigeru AIHARA. The page numbered "three" of the declaration indicated a different "second inventor" Shyoji Yoshioka and different "third inventor" Makiko Kise.

The declaration filed on 31 May 2000 also indicates a correction to the spelling of the fifth and seventh listed inventor's names. Hisashi SHIODA appears as the fifth inventor on the publication, which is corrected to SHIOTA on the declaration. Likewise, Jun ARAKANE appears on the publication as the seventh inventor, which is corrected to Jun ARAGANE on the declaration. No explanation is provided for either change.

Section 201.03 of the MPEP states in pertinent part,:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

(Emphasis added.)

The declaration as filed is unacceptable. The declaration names two individuals as the first or sole inventor, two individuals as second inventor, two individuals as third inventor. The declaration does not list all the inventors named on the publication in one declaration. As discussed above, the declaration must list all inventors in the order as published with all names listed on the same declaration.

As indicated in Section 201.03 of the Manual of Patent Examining Procedure, where a typographical or transliteration error in the spelling of an inventor's name is discovered, a petition under 37 CFR 1.48(a) is not required. However, the Office should be notified of the error. In the instant application, applicants do not give an explanation of the difference in the fifth and seventh listed inventors last names. No explanation is given as to why the inventor did not note the correction of their last names in the published international application. An explanation is required.

CONCLUSION

The petition under 37 CFR 1.182 is **DISMISSED WITHOUT PREJUDICE**.

A proper response is a new declaration, signed by the inventors as listed on the publication. As discussed above, an explanation is required regarding the last name of the fifth and seventh named inventors.

If reconsideration of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182", and must include the requisite petition fee and an acceptable explanation of the facts as discussed above. Failure to file a proper response in a timely manner will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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